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10/056,473	01/23/2002	Jude S. Sauer	INE-0002-C2	5120

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EXAMINER

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/056,473
Filing Date: January 23, 2002
Appellant(s): SAUER, JUDE S.

H. M. Bedingfield
For Appellant

This is in response to the appeal brief filed 27 December 2010 appealing from the Office action mailed 27 November 2009.

EXAMINER'S ANSWER

(1) Real Party in Interest

The examiner has no comment on the statement, or lack of statement, identifying by name the real party in interest in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The following is a list of claims that are rejected and pending in the application: Claims 5-10, 12, 13, 20, 21, 23-39, 42-45, 51-58, 63-73 and 80-88 are pending. Claims 63-73 and 80-88 are withdrawn. Claims 5-10, 12, 13, 20, 21, 23-39, 42-45 and 51-58 are rejected.

(4) Status of Amendments After Final

The examiner has no comment on the appellant's statement of the status of amendments after final rejection contained in the brief.

(5) Summary of Claimed Subject Matter

The examiner has no comment on the summary of claimed subject matter contained in the brief.

(6) Grounds of Rejection to be Reviewed on Appeal

The examiner has no comment on the appellant's statement of the grounds of rejection to be reviewed on appeal. Every ground of rejection set forth in the Office action from which the appeal is taken (as modified by any advisory actions) is being maintained by the examiner except for the grounds of rejection (if any) listed under the subheading "WITHDRAWN REJECTIONS." New grounds of rejection (if any) are provided under the subheading "NEW GROUNDS OF REJECTION."

(7) Claims Appendix

The examiner has no comment on the copy of the appealed claims contained in the Appendix to the appellant's brief.

(8) Evidence Relied Upon

5,431,666

Sauer et al.

7-1995

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claims 12, 13, 53, 54, 56 and 58 are rejected under 35 U.S.C. 102(b) as being anticipated by Sauer et al. (US Patent 5,431,666).

Claim 12, 13: Sauer discloses a device that contains a tongue member (37b) having a distal section insertable into a wound. The device also contains a face (distal face of grooves 40, 42 next to element 44. This face can be seen in Figures 2 and 12-14 - it is unlabeled) separated from the tongue by a gap (44). The device further contains a guidewire tube (40) disposed through an elongate body assembly (37). The distal end of the guidewire tube is next to an opening in the tongue member (the opening in 37b is unlabeled, but it is clear from the drawings that there is an opening used to accommodate elements 16, 18).

Claim 53, 54: Sauer discloses a tip for a surgical apparatus that contains a window (44), a first wall (distal face of grooves 40, 42 next to element 44. This face can be seen in Figures 2 and 12-14 - it is unlabeled) at an angle to the longitudinal axis and a second wall (proximal face of 37b) having a tongue (37b) with an opening (unlabeled but used to hold ferrules 16, 18). The base of the tongue forms the bottom portion of the window (see Figure 2).

Claim 55, 56: The proximal end of the tongue forms a T-shaped extension (the two needle holders 40, 42 are formed as grooves in element 37 - this creates a T-shaped extension as shown in Figure 2).

Claim 53 (alternate rejection), 58: Sauer discloses a device that contains a window (opening of region 34 in Figure 2), a first wall (face of element 32), a second wall (proximal face of element 30b-shown in Figure 2) and a tongue (34) that forms a

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bottom portion of the window. The tongue contains a longitudinal opening (element 30 is a tube) with an opening at the distal end that is proximal to the distal end of the tip (opening at 30b is used to accommodate element 37b).

Claim Rejections - 35 USC § 103

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 51 and 5-10, 20, 21, 23-39, 42-45 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sauer'666.

Claim 51, 52: Sauer teaches a device that contains a window (opening at 44); a first wall (distal face of grooves 40, 42 next to element 44. This face can be seen in Figures 2 and 12-14 - it is unlabeled); a second wall (proximal face of 37b) having a ferrule holder (opening in 37b holds ferrules 16, 18 as shown in Figure 2) and a tongue (44) extending between the first and second walls.

Sauer'666 discloses the claimed invention except Sauer'666 does not teach that the ferrule holder is separable from the tongue. The Sauer'666 device would work in the same way if the ferrule holder were separable from the tongue. It would have been obvious to one having ordinary skill in the art at the time the invention to make the ferrule holder separable from the tongue, since it has been held that constructing a formerly integral structure in various elements involves only routine skill in the art. *Nerwin v. Erlichman*, 168 USPQ 177, 179. and MPEP 2144.04. Also, see further

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arguments above regarding *In re Dulberg*, (289 F.2d 522, 523, 129 USPQ 348, 349 (CCPA 1961)). The case states that it would be obvious to make two parts separable if there is any reason to make them removable from one another. Applying this to the present case, it is old and well known to make parts separable from a medical device in order to specific parts of the device or to sterilize the device for a future use.

Claim 5, 6, 7, 8: Sauer further teaches that the device contains an elongate body assembly (37) connecting a body portion (12) to the tongue member (44). The device further contains two elongate needles (36, 38) positioned within the elongate body assembly (in grooves 40, 42) (column 5, lines 20-36). The first and second needles is movable by a first and second levers (70, 72 respectively) (column 6, lines 38-44).

Claim 9: Sauer teaches a body portion (12) having first and second levers (160, 162) pivotally secured to the body portion (via element 164, see Figures 5-6) connected with the first and second needles (column 8, lines 4-14). Sauer does not disclose the use of multiple colors to identify which lever is interacting with which needle. However, the concept of color-coding is well known in the art. Patentability cannot be predicated on color-coding a surgical device. The color-coding so as to identify which needle each handle is operating would have been entirely obvious. Further, applicant has not shown any functional criticality for color-coding the levers. The device will perform the same way regardless of the color.

Claim 10: Sauer teaches a body portion (12) having first and second levers (160, 162) pivotally secured to the body portion (via 164, see Figures 5-6). The first and

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second levers are mounted to the distal end of the body portion (see Figures 1, 5 and 6).

Claim 20, 21: Sauer teaches a body portion (12); a tubular portion (170) attached to the distal end of the body; and a lever (172) having a distal end operatively coupled to the distal end of the body portion. The lever is parallel to the longitudinal axis in the closed position (see Figure 5).

Claim 23: Sauer teaches a body portion (12); a tubular portion (170) attached to the distal end of the body; and a lever (172) having a distal end operatively coupled to the distal end of the body portion. The device further contains a first and second link (36a, 38a) connected to the lever at one end and to first and second slidable member (70 and 72) at the other end of the link. The slidable members move within the body portion (see Figures 5 and 6).

Claim 24: Movement of the lever towards the proximal end of the body portion causes one slidable member to move towards the distal end of the body portion and the other slidable member to move away from the distal end of the body portion (column 8, lines 26-58).

Claim 25, 26: Sauer discloses a drive block (106) in which the slidable member cooperates with the drive block to move the drive block with the slidable member (column 11, lines 12-30).

Claim 27, 29: The drive block is biased with a spring (118, 120) (column 7, lines 23-28).

Claim 28: The drive block contains a longitudinal opening (see Figure 4 or 8).

Claim 23 (alternate rejection), 39: Sauer teaches a body portion (12); a tubular portion (170) attached to the distal end of the body; and first and second levers (160, 162) having a distal end operatively coupled to the distal end of the body portion. The device further contains first and second link (36a, 38a) connected to the lever at one end and to first and second slidable member (70 and 72) at the other end of the link. The slidable members move within the body portion (see Figures 5 and 6).

Claim 30, 31, 33, 34, 35, 36, 37: Movement of the lever towards the proximal end of the body portion causes one slidable member to move towards the distal end of the body portion and the other slidable member to move away from the distal end of the body portion (column 8, lines 26-58). The slidable members (70, 72) are needle drivers.

Claim 32: The needles are disposed within the tubular portion (Figures 10, 11).

Claim 42, 43, 44, 45: Sauer teaches a body portion (12), a tubular portion (30) and first and second levers (160, 162) pivotally secured to the body portion (via element 164, see Figures 5-6) connected with the first and second needles (column 8, lines 4-14). Regarding claim 45, Sauer does not disclose the use of multiple colors to identify which lever is interacting with which needle. However, the concept of color-coding is well known in the art. Patentability cannot be predicated on color-coding a surgical device. The color-coding so as to identify which needle each handle is operating would have been entirely obvious. Further, applicant has not shown any functional criticality for color-coding the levers. The device will perform the same way regardless of the color.

Claim 57 is rejected under 35 U.S.C. 103(a) as being unpatentable over Sauer'666.

Claim 57: Sauer'666 discloses the claimed invention except Sauer'666 does not teach that the ferrule holder is separable from the tongue. It would have been obvious to one having ordinary skill in the art at the time the invention to make the ferrule holder separable from the tongue, since it has been held that constructing a formerly integral structure in various elements involves only routine skill in the art. *Nerwin v. Erlichman*, 168 USPQ 177, 179. and MPEP 2144.04.

Claim 57 is rejected under 35 U.S.C. 103(a) as being unpatentable over Sauer'666.

Claim 57: Sauer'666 discloses the claimed invention except Sauer'666 does not teach that the ferrule holder is separable from the tongue. It would have been obvious to one having ordinary skill in the art at the time the invention to make the ferrule holder separable from the tongue, since it has been held that constructing a formerly integral structure in various elements involves only routine skill in the art. *Nerwin v. Erlichman*, 168 USPQ 177, 179. and MPEP 2144.04.

(10) Response to Argument

(A) Claims 12, 12, 53, 54, 56 and 58 have been rejected under 35 USC 102(b) as being anticipated by Sauer'666

Applicant's arguments state that item 40, identified by Examiner as a guide wire channel, is actually a needle channel and therefore does not read on the limitation of a guidewire channel. However, Applicant has only claimed a guidewire channel, *not* a

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channel *and* a guidewire. The channel of element 40 is capable of accommodating a guidewire due to its size and shape.

Applicant also argues that the ferrule holder cavities (cavities for holding elements 16, 18) cannot serve as and of the guidewire lumen because the ferrule holder cavities do not go through the tongue, as claimed. However, the claims do not require that the guidewire lumen passes through the tongue. The claim merely states "a distal end of the guide wire tube being disposed adjacent a distal opening of the tongue member." The cavities for holding elements 16, 18 are adjacent to a distal opening of tongue (37b), which the cavities for holding elements 16, 18 are (see Figures 2, 12-14). The claim only requires that the guidewire lumen passes through the elongate body. The claim does not require that the guidewire lumen passes completely through the distal end of the tongue.

The argument that the device of Sauer'666 cannot accommodate a guidewire because a needle, not a guidewire, passes through element 40 is not persuasive since the claim does not recite a guidewire.

No additional arguments were made regarding independent claim 53. Claim 53 does not recite a guidewire lumen.

(B) Claims 51 and 5-10, 20, 21, 23-39, 42-45 have been rejected under 35 USC 103(a) as being patentable over Sauer'666

Applicant argues that Examiner has not cited prior art that includes projections on the ferrule holder receivable within grooves of the tongue for attaching the tongue more securely to the ferrule holder.

As stated in the rejection, the ferrule holder (openings in element 37b that holds ferrules 16, 18) is integral with tongue 44. Making a structure that is integral into separable components has been established as an obvious modification, since it has been held that constructing a formerly integral structure in various elements involves only routine skill in the art. *Nerwin v. Erlichman*, 168 USPQ 177, 179.

Further, Sauer'666 clearly shows projections on the ferrule holder in the form of element 56, located on the tips of ferrules 16, 18 (see Figure 2 and column 6, lines 3-18). Sauer'666 states that element 56 is swaged around a suture, and since swaging includes spreading the material into shape, it forms a projection. The language of the claim merely requires that the projections are "...receivable within grooves of the tongue...". This language is functional since the claim does not positively recite grooves. The projections 56, are *capable of* being received within grooves, and therefore, Sauer'666 reads on the claimed limitations.

Applicant argues that the claimed securing mechanism serves to better secure the ferrule holder to the tongue. However, it is noted that the features upon which applicant relies (i.e., grooves as part of an improved securing mechanism) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

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(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

/Lindsey Bachman/
Examiner, Art Unit 3734

Conferees:

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March 13, 2011

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